

a patient comprising:

distracting said first and second vertebrae;

removing a portion of an intervertebral disc positioned between said first and second vertebrae thereby creating a space; and

implanting an elongated bone implant into said space, said bone implant comprising a section of bone that comprises a substantially planar upper surface and a substantially planar lower surface that is opposite said substantially planar upper surface, an anterior end and a posterior end opposite said anterior end, a first side wall and a second side wall opposite said first side wall, wherein said first side wall and said second side wall extend between said substantially planar upper surface and said substantially planar lower surface, and wherein said second side wall defines either a concave surface or both linear and concave surfaces;

wherein said elongated bone implant is positioned in said space such that said second side wall faces inwardly.

71. (Original) The method of claim 70, wherein said elongated bone implant is positioned such that said anterior end is directed toward the anterior side of said patient and said posterior end is directed toward the posterior side of said patient.

#### **Remarks**

The amendment to the specification at the top of page 1, reciting the claim of priority does not add new matter and merely clarifies the relationship between the present application, "a 371 of PCT/US98/17769, filed 08/27/98," [see Exhibit A: the official filing receipt] and the parent application, USSN 08/920,630, from which priority was expressly claimed. [see also Exhibit A: the official filing receipt.].

The Official Filing Receipt incorrectly states that the present application, which was granted a § 102(e) filing date of 08/20/01, was both:

"a 371 of PCT/US98/17769, filed 08/27/98,

and a CIP of USSN 08/920,630, filed 08/27/97, ABN”

However, the present application is merely the 371 national phase of PCT/US98/17769, filed 08/27/98, utilizing the same specification, and claiming priority to the latter application’s PCT filing date (08/27/98). In addition, on its face, the PCT priority application, PCT/US98/17769, in turn claims priority from USSN 08/920,630, filed 08/27/97. [See Exhibit B: cover page of PCT/US98/17769.] Thus, it is clear that PCT/US98/17769 is claiming priority directly from USSN 08/920,630.

In addition, the declarations [Exhibit C] that were originally filed with this application expressly reflect that the present application recited that priority was from both PCT/US98/17769 and USSN 08/920,630. Thus, both applications from which priority was claimed were disclosed at the time the present application was filed. Applicants are merely clarifying the relationship between the two applications to reflect what was shown on the face of PCT/US98/17769.

For all these reasons, the amendment to the specification is proper, ripe and does not add new matter. Its entry is respectfully requested.

### **Bases for Rejection**

Claims 59-71 are rejected under 35 U.S.C. § 102(e) for allegedly being anticipated by U.S. Pat. 6,258,125 (Paul).

Claims 59-66 and 68-70 are rejected under 35 U.S.C. § 102(b) for allegedly being anticipated by U.S. Pat. 5,728,159 (Stroeve).

Claims 59-71 are rejected under 35 U.S.C. § 102(b) for allegedly being anticipated by WO 98/17209 (Pafford).

The Applicants will address each basis for rejection in Sections I-III, respectively, which follow.

#### **I. Anticipation over U.S. Pat. 6,258,125 (Paul)**

Claims 59-71 are rejected under 35 U.S.C. § 102(e) for allegedly being anticipated by U.S. Pat. 6,258,125 (Paul). Paul, which issued on 07/10/01, has an earliest claimed priority date of 08/03/98. However, when the Applicants' claim of priority is properly stated, as amended herein, the present invention claims priority back to 08/27/97, based upon the filing date of USSN 08/920,630. Moreover, as argued in Applicants' Response to the Official Action of 12/05/02 at page 4, the Applicants are claiming the embodiments of Figures 8A-8C of the present application which are also Figures 8A-8C of the Applicants' priority application, USSN 08/920,630, filed 08/27/97. Thus, when the Applicants' claim of priority is properly recited, Paul is not prior art. The withdrawal of this basis for rejection and the allowance of claims 59-71 is respectfully requested.

## **II. Anticipation over U.S. Pat. 5,728,159 (Stroeve)**

Claims 59-66 and 68-70 are rejected under 35 U.S.C. § 102(b) for allegedly being anticipated by U.S. Pat. 5,728,159 (Stroeve). However, to be prior art under 35 U.S.C. § 102(b), Stroeve would have to be published or issued more than a year prior to the Applicants' earliest claimed priority date. But Stroeve issued on 03/17/98, which is less than one year prior to the filing date of the Applicants PCT priority application, which was filed on 08/27/87, and later than the Applicants' earliest claimed priority date of 08/27/97. Thus, at best, Stroeve must rely upon its filing date of 03/17/97 so as to be prior art under 35 U.S.C. § 102(a).

Rejected claims 59-66 and 68-70 are directed to an "elongated bone implant" wherein the term "elongated" refers to the length in the horizontal plane. Examples of the "elongated bone implants of the present claims are shown in the Applicants' Figures 8A and 8D. Consistent with this use of the term "elongated," Applicants' claims 62 and 63 recite a sidewall to sidewall thickness for the anterior and posterior ends of 4-5 mm and 4-6 mm, respectively. Further, claim 68 reflects that the term "elongated" refers to the length from the "anterior end" to the "posterior end"

("20 mm to about 26 mm in length from said anterior end to said posterior end.").

The Patent Office contends that Figure 2 of Stroever discloses "a bone implant comprising a substantially planar upper and lower surfaces, an anterior end and a posterior end, a first side wall and second side wall, wherein the first and second side wall (indicated as P) comprises a concave surface and the first wall (A) comprises a convex surface." [Official Action at page 3.] The Patent Office also contends that Figure 1 of Stroever has concave walls L and M. [Official Action at page 3.] However, even if these statements were true, Stroever would not be anticipatory.

On its face, the implants of Stroever are not "elongated" as recited in the Applicants' claims. Rather, they have a cross-sectional width that is about equal to their cross-sectional length. Consistent with this, Stroever refers to the embodiments of his Figures 1-4 as having "diameters", which means that the "cross-sectional" distances (width and length) are about equal.

The serrated fibular **cross-section** bone grafts shown in FIG. 1 can have exemplary **diameters** of about 10-14 mm and about 15-18 mm, with exemplary length of 8 mm, 10 mm, 12 mm and 14 mm.

[Stroever at col. 2, lines 20-21; emphasis added in bold.]

\* \* \*

The serrated humeral **cross-section** bone grafts shown in FIG. 2 can have exemplary **diameters** within the range of about 19-22 mm, and exemplary lengths of 8 mm, 10 mm, 12 mm and 14 mm.

[Stroever at col. 2, lines 32-35; emphasis added in bold.]

\* \* \*

The serrated tibial **cross-section** and serrated femoral **cross-section** bone grafts shown respectively in FIGS. 3 and 4 can have exemplary **diameters** within the range of 23-27 mm, and exemplary lengths of about 10 mm, 12 mm, 14 mm and 16 mm.

[Stroeever at col. 2, lines 45-49; emphasis added in bold.]

Thus, by use of the word “diameter” to describe the implants of Figures 1-4<sup>1</sup>, Stroeever discloses that the implants of his invention have a length and a width in the same cross sectional plane that are about equal.

Moreover, when Stroeever uses the term “length” or “elongate,” he is referring to the vertical length of the implant:

Additionally, **elongate shaft** embodiments can have equivalent diameters, but exemplary **lengths** of 20 mm, 30 mm, 40 mm, 50 mm, 60 mm, 70 mm and 80 mm.

[Stroeever at col. 2, lines 23-26; emphasis added in bold.]

\* \* \*

According to the present invention, a bone graft section for graft in a patient comprises a body portion cut from **elongate cortical bone**, . . . .

[Stroeever at col. 1, lines 19-21; emphasis added in bold.]

\* \* \*

**Exemplary lengths** of serrated bone graft sections in accordance with the present invention range from about 8 mm to about 80 mm, with exemplary **diameters** ranging from about 10 mm to about 27 mm.

[Stroeever at col. 1, lines 60-63; emphasis added in bold.]

Thus, by use of the term “diameter,” Stroeever discloses bone implants having substantially similar distances in going from side to side and from front to back. Moreover, by use of the terms “length” and “elongate”, Stroeever is referring to the

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<sup>1</sup> The implants of Figs 5-7 of Stroeever are “wedges” and thus, do not have parallel opposing faces. See Stroeever at col. 2, line 60.

vertical height of the implant. Because the bone implants of Stroever have substantially similar distances in going from side to side and from front to back, the implants disclosed in Stroever are not anticipatory of the elongated bone implants of the Applicants' invention.

### **III. Anticipation over WO 98/17209 (Pafford)**

Claims 59-71 are rejected under 35 U.S.C. § 102(b) for allegedly being anticipated by WO 98/17209 (Pafford). On its face, Pafford has a publication date of April 30, 1998. In contrast, the present application is entitled to a priority filing date of 08/27/97. Thus, Pafford is not prior art to the present application.

### **CONCLUSION**

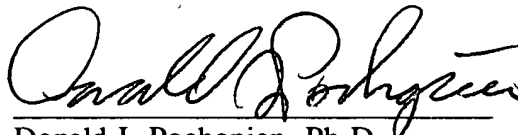
In view of the amendment clarifying the Applicants' claim of priority, Paul and Pafford are no longer prior art. In view of the arguments herein, the rejection of claims 59-66 and 68-70 over Stroever have been rebutted.

Thus, the allowance of claims 59-71 is respectfully requested.

Respectfully submitted,

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